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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MANABU IWAMOTO and KENJI OSHIMA

Appeal 2009-004015
Application 10/543,051
Technology Center 2800

Before JOHN C. KERINS, STEVEN D.A. MCCARTHY and MICHAEL W.
O'NEILL, *Administrative Patent Judges*.

KERINS, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

Appellants have filed a Request for Rehearing (“Request”) under 37 C.F.R. § 41.52. The Request seeks reconsideration of our Decision bearing a date of May 28, 2010, and mailed June 1, 2010 (“Decision”) entering new grounds of rejection against claims 7 and 9 under 35 U.S.C. § 112, second paragraph, and against claims 11 and 12 under 35 U.S.C. § 112, first paragraph.² We have jurisdiction over the Request under 35 U.S.C. § 6(b).

Appellants assert that we have misapprehended or overlooked several points, identified in the Request, that pertain to each of the new grounds of rejection. We grant the Request to the extent that we have now considered the arguments, and herein vacate the rejection of claims 7 and 9 under 35 U.S.C. § 112, second paragraph, but otherwise deny the Request.

Claims 7 and 9--Indefiniteness under 35 U.S.C. § 112, Second Paragraph

The rejection of these claims was predicated on our conclusion that the claim language reciting “an empty ink container recognizing means” which “recognizes that the ink container is exhausted” when an elapsed time is longer than a predetermined inkless time, and which “reads out numeric information from a storage means which is provided on [an] ink container” and “sets the inkless time on the basis of the numeric information”, is a means-plus-function limitation subject to the requirements of 35 U.S.C. § 112, sixth paragraph. Appellants have not contested this, and instead posture that the conclusion will be assumed to be correct “for the sake of argument”. (Request A-4). Appellants fail to identify any asserted misapprehension on our part, or any facts or evidence that may have been

² The Decision reversed the appealed rejection of claims 7, 9, 11 and 12 under 35 U.S.C. § 103(a).

overlooked by us, in reaching this conclusion forming the cornerstone for the rejection.

Appellants take issue with our finding that there is no disclosure in Appellants' Specification of any structure that corresponds to the means-plus-function limitation calling for an "empty ink container recognizing means" (hereafter "EICRM"). More specifically, Appellants contend that "the specification does show structure for the claimed element." (Request A-4). In support of that contention, Appellants identify a number of excerpts from the written description in the Specification that describe the operation or function of the EICRM, as well as that the EICRM is connected to a connector 9 that is to be electrically connected to a contact 83 of a storage means 8 so that a parameter stored in the storage means representing an inkless time may be read out by the EICRM. (Request A-4 to A-6).

Appellants' position is that these excerpts evidence that:

[t]he specification clearly indicates that the [EICRM] is a device that can electrically connect to a memory and read out information -- a parameter stored in memory -- from that memory, as well as set a time by referring to a correction table. Hence, it is clear that it is a computer or computer module.

(Request A-6).

Further citing to guidance set forth in MPEP § 2181, and examples from case law included therein, Appellants further urge that,

the Board failed to appreciate that the specification amply described structure of an [EICRM] such that ordinarily skilled artisan would understand what structure must perform the function recited in the means-plus-function limitation (e.g., implemented by or on a computer)...and hence would be clear.

(Request A-7).

What is clear is that Appellants' claim that "the specification *does show structure* for the claimed element" (Request A-4)(emphasis added) is not borne out by the excerpts presented, nor by the commentary thereon presented by Appellants' representative. Appellants' Specification contains no explicit disclosure of such structure. A disclosure of structure corresponding to a means-plus-function limitation may, however, be implicit in the written description, but only if it would have been clear to those skilled in the art what structure *must* perform the function recited in the means-plus-function limitation. *Atmel Corp. v. Information Storage Devices Inc.*, 198 F.3d 1374 (Fed. Cir. 1999)(discussing that this proposition is consistent with holding in *In re DosseI*, 115 F.3d 942, 946-47 (Fed. Cir. 1997); see also MPEP § 2181(II).

Appellants contend that the Specification makes it clear that the structure is "a computer or computer module". (Request A-6). Appellants further contend that the ordinarily skilled artisan would recognize that the structure that must perform the function is "(e.g., implemented by or on a computer)". (Request A-7). As Appellants point out, the EICRM is electrically connected to a memory to read out information from the memory. (Spec. 9, II. 24-31). This implies that the EICRM must be an electronic processor. In addition, the Specification discloses an algorithm by which the claimed EICRM operates. The Specification discloses that the EICRM recognizes that the ink container is exhausted by receiving an elapsed time measured by the time measuring means; reading out numeric information from an electronic storage means which is provided on the ink container, setting the inkless time on the basis of the numeric information;

and comparing the elapsed time to the inkless time. (Spec. 5, l. 32 – Spec. 6, l. 4 and Spec. 9, ll. 14-31). The numerical information stores inkless time for standard inks as well as correction values to account for various particular circumstances. (Spec. 9, l. 32 – Spec. 13, l. 6). The EICRM sets the inkless time by adding the correction values to the inkless time for the standard ink. (*See, e.g.*, Spec. 10, ll. 21-24).

Upon further consideration of the above, we are persuaded that the Specification sufficiently identifies the structure corresponding to the claimed empty ink container recognition means as an electronic processor programmed to perform a disclosed algorithm.³ Accordingly, we hereby vacate the new ground of rejection of claims 7 and 9 under 35 U.S.C. § 112, second paragraph, that was instituted in the Decision.

Claims 11 and 12--Non-enablement under 35 U.S.C. § 112, First Paragraph

Appellants contend that we have made errors of law in rejecting claims 11 and 12 as being unduly broad under 35 U.S.C. § 112, first paragraph, in view of the precedent set forth in *In re Hyatt*, 708 F.2d 712 (Fed. Cir. 1983). Appellants contend that claim 11 is not a “single means” claim, and that, by statute (35 U.S.C. § 112, sixth paragraph), the means-plus-function clause in claim 11 may not be construed as covering any conceivable means for achieving the stated result. (Request A-8 to A-9).⁴

³ Our decision is limited to the EICRM and functions expressly set forth in claim 7, and is not intended to address the adequacy of disclosure of other possible embodiments of an EICRM that would operate in a system in which the inkless time is recorded as a bar code, letter or symbol, mentioned at page 13 of the Specification as alternative approaches to recording the inkless time.

⁴ Although we conclude that “Appellants have used the term ‘means’ to invoke § 112, sixth paragraph” (Decision 6), we do not conclude that

Appellants assert that claim 11 recites a combination that includes “an ink container . . . comprising storage means [which is provided on the ink container]” which stores the numeric information for setting an inkless time corresponding to the time corresponding to the kind of ink therein”. (Request A-8). Appellants contend that the means recitation appears in combination with another recited element, presumably an ink container. (*Id.*).

Claim 11, when read in accordance with the precepts of English grammar (*see In re Hyatt*, 708 F.2d at 714), calls for an ink container *comprising*⁵ the storage means. This means, both in plain language and in long-accepted claim construction principles, that the ink container *includes* the storage means, and not that the ink container is another element recited along with the means recitation. In this respect, the claim is no different from the claim in *Hyatt*, which recited a Fourier transform processor comprising incremental means for incrementally generating the Fourier transformed incremental output signals. The Federal Circuit rejected the argument that the claim recited several elements, notably a Fourier transform processor (comparable to the claimed ink container), in combination with the means element, when the former, as here, was recited as *comprising* the latter. *In re Hyatt*, 708 F.2d at 714.

Appellants’ use of the term “means” succeeded in bring claim 11 within the protections of that statutory section.

⁵ comprise: 1. to include or contain. Dictionary.com Unabridged, Based on the Random House Dictionary, © Random House, Inc. 2010 (accessed at <http://dictionary.reference.com/browse/comprise> on November 11, 2010)

Appellants appear to be contending that the claim language reciting a plethora of method steps which the claimed “ink container . . . comprising storage means” might be used in carrying out, in particular the language reciting that “a numeric information is read out from a storage means which is provided on the ink container to store a numeric information . . .”, evidences that the storage means is recited in combination with another element. We are not persuaded that this language removes claim 11 from the realm of being a “single means” claim.

Claim 11 is, at its essence, a device or apparatus claim. Apparatus claims cover what a device is, not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990).

The inclusion of a lengthy recitation of the method that the device will be used in provides no positive limitations on the claims. Appellants recognize as much, in that they do not argue that such elements as an “ink fountain” and a “printing drum”, for example, that appear in method portion of claim 11 are elements that are recited in combination with the storage means. That the method recitation identifies a storage means provided on the ink container, as though they might possibly be two separate elements, is inconsistent with the device portion of the claim that requires that the storage means is a component of (and the only recited component of) the ink container. As such, the presence of that language gives rise to an informality that would need to be remedied, should the instant rejection be otherwise overcome by appropriate amendment of the claim to include more than the single means currently recited.

Moreover, if Appellants’ argument were accepted, claim 11 would be interpreted as including an ink container and a storage means as separate

elements recited in a combination, while at the same time the storage means is a part of the ink container element. Such an interpretation defies commonly and widely accepted claim construction principles. With claim 11 being directed to a device, i.e., an ink container, we look to see what elements are recited as being included in that device, and find only a storage means.

Appellants' contention that legal error exists in our position that claim 11, being a single means claim, results in the means-plus-function clause being construed as covering any conceivable means for achieving the stated result, misses the mark. Appellants contend that the decision in *re Donaldson*, 16 F.3d 1189 (Fed. Cir. 1994), requires us, by application of 35 U.S.C. § 112, sixth paragraph, to apply a "broadest reasonable construction" that limits the clause to the corresponding structure, material, or acts described in the specifications and equivalents thereof. (See 35 U.S.C. § 112, para. 6).

The sixth paragraph is applicable, by its own terms, to claims "for a combination". (*Id.*) *A fortiori*, it is not applicable to claims that recite only a single means, such as claim 11. The Federal Circuit in the *Hyatt* case foreshadowed what might have resulted in a possible conflict between that decision and the *Donaldson* decision handed down years later, noting that:

[t]he final paragraph of §112 saves *combination* claims drafted using means-plus-function format from this problem by providing a construction of that format narrow enough to avoid the problem of undue breadth as forbidden by the first paragraph. But no provision saves a claim drafted in means-plus-function format which is not drawn to a combination, i.e., a single means claim.

In re Hyatt, 708 F.2d at 715.

Appellants are only entitled to avail themselves of the constricts of claim construction emanating from the sixth paragraph of 35 U.S.C. § 112 if claim 11 is determined to be a combination claim. We have concluded that it is not.

DECISION

We have carefully reviewed Appellants' Request for Rehearing. We have granted the Request to the extent that Appellants' arguments have been considered, and to the extent that we vacate the rejection of claims 7 and 9 under 35 U.S.C. §112, second paragraph. The Request is denied with respect to making any changes in the decision to enter the new ground of rejection directed to claims 11 and 12.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REQUEST GRANTED-IN-PART, DENIED-IN-PART

JRG

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